

Application No. 10/645,444
Amendment dated April 27, 2004
Reply to Office Action of 04/09/2004
Attorney Docket No. 03-12373

DOUBLE PATENTING

In paragraph 2 of the Office Action, the Examiner has provisionally rejected claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/349,255 in view of Crewe (U.S. Patent No. 5,649,327) and Daniels (U.S. Patent No. 4,887,319).

In response, the Applicant files herewith a terminal disclaimer to overcome the Examiner's rejection and believes the claims are thereby allowable.

REMARKS/ARGUMENTS

Claims 1-13 are pending. Claims 8-13 are new claims, and these claims have been presented in light of the Examiner's suggestions that claims 2-7 would be allowable if rewritten in independent form. Accordingly, claim 8 is claim 2 rewritten in independent form and claims 9-13 depend variously from claim 8. No new matter has been added to this application by way of any of the foregoing amendments. Applicant respectfully submits that claims 1-13 are in condition for allowance.

Claim Rejections Under 35 U.S.C. § 103

In paragraph 4 of the Office Action, the Examiner has rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Crewe (U.S. Patent No. 5,649,327) in view of Daniels (U.S. Patent No. 4,887,319).

The Examiner asserts that Crewe substantially discloses the invention as claimed. The Examiner notes that Crewe fails to teach a shade having a split

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configuration. To make up for this deficiency, the Examiner cites Daniels as teaching a neck shade with a split configuration as shown in Figure 1. The Examiner asserts that the split shape allows the shade to better conform to the contours of the wearer's upper torso. The Examiner then concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the pouch of Crewe with a split configuration as taught by Daniels so that the shade may better conform to the wearer's upper torso.

It is respectfully submitted that the Examiner has not established a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what is the inventor has done. "To support the conclusion the claimed invention is directed to obvious subject matter, either the references expressly or implicitly suggest the claimed invention or the examiner must present a convincing

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line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In response, the Applicant submits that a *prima facie* case of obviousness has not been established. More specifically, the Applicant submits that the Crewe reference in view of Daniels does not teach or disclose all the elements as recited in claim 1. That is, the Crewe reference fails to teach a cap wherein two or more shade attachment members may be positioned on the inner surface of the crown near a front portion of the crown. Furthermore, the Applicant submits that Crewe does not teach that a pouch is attached to the inner portion of the crown.

In sharp contrast, Crewe teaches a cap with a neckpiece that is retractable into a pocket that is positioned on the outer portion of the crown. Furthermore, any attachment members for the shade piece are positioned on the outer periphery of the headband.

Additionally, there is no teaching or suggestion that the pouch may be positioned on the inner portion of the crown. Rather, Crewe teaches away from the invention as presently claimed as it is an object of the invention to have the neckpiece stowable within a closable pocket on the outside of the hat without effecting the fit of the headgear (See Col. 1, lines 34-39).

Moreover, Daniels fails to make up for the deficiency of the Crewe reference. Daniels merely teaches a unitary contiguous face and neck protector for a hard hat

headgear. Daniels does not teach or disclose that two or more shade attachment members may be positioned on the inner surface of the crown near a front portion of the crown. Furthermore, Daniels does not teach that a pouch is attached to the inner portion of the crown. Accordingly, Applicant respectfully submits that a *prima facie* case of obviousness has not been established and requests the rejection be withdrawn.

Furthermore, the Applicant submits that Daniels fails to teach a shade having a split configuration as asserted by the Examiner. The Daniels reference teaches a weather-protective device having a slight curve yet the device is still unitary. In contrast, the shade as recited in claim 1 has a split configuration as shown in Figure 7.

Additionally, the Applicant submits that the Examiner has relied upon non-analogous arts since Daniels is directed to a face and neck protector for a hard hat as shown in Figure 2 whereas the Applicant's invention as recited in claim 1 is directed to a cap having a sun shade for shading a personal user from the sun.

As stated In Re Clay, 23 U.S.P.Q. 2d 1058, the criteria for determining whether prior art is analogous has been developed over a period of years and includes the elements:

1. Whether the art is from the same field of endeavor, regardless of the problem addressed, and
2. If the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

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The Court of Appeals in this case cited In Re Deminski, 796 F.2d 436, 432, 230 U.S.P.Q. 313, 315 and In Re Wood, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174.

Taking these elements into account, one must first look at whether the art is from the same field of endeavor. The Applicant submits that the presently claimed invention and the Daniels reference are directed to different fields of endeavor. That is, the presently claimed invention is directed to a cap, hat, or visor that is of a "baseball-type fashion." In contrast, the Daniels reference is directed to hard hats. Individuals using or designing baseball-type caps/visors as presently claimed would not be involved in nor consider the technologies involved with a hard hat. That is, hard hats are safety devices whereas the presently claimed invention is for recreational or novelty purposes. Accordingly, Applicant submits that the presently claimed invention and the Daniels reference are directed to different fields of endeavor.

Furthermore, the Applicant submits that the Daniels reference is not pertinent to the particular problem with which the inventor is involved. That is, the Daniels reference is directed to providing a cover that is waterproof, thermally insulated, covers the bridge portion of the face of the wearer and the front, back and sides of the neck of the wearer. Accordingly, the unitary face and neck cover as disclosed in Daniels reference is directed to shutting out the weather elements such as wine, snow, rain, and the like from contact with the wearer.

In sharp contrast, the cap as disclosed in the presently claimed invention is directed to shielding the wearer's neck and parts of the face from sun exposure. The

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presently claimed invention is not designed to solve the problem of protecting the user's face and neck from wind, snow, and rain. Furthermore, the shade of the presently claimed invention only covers a portion of a neck and parts of the face whereas Daniels reference teaches that the neck cover covers substantially all of the neck and a portion of the face. Accordingly, the presently claimed invention would not solve the problems set forth in Daniels because the shade only covers a portion of the wearer's neck. Thus, the Applicant submits that the presently claimed invention and Daniels seek to solve different problems.

Accordingly, in view of the above, the Applicant submits that claim 1 is not obvious in view of the combination of Crewe and Daniels. Thus, the Applicant submits that the rejection be withdrawn and claim 1 be allowed.

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Conclusion

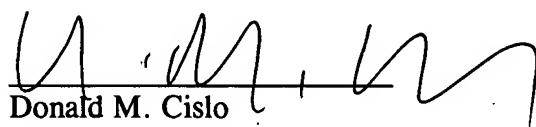
Having responded to each of the Examiner's concerns, Applicant asserts that the application is now in condition for allowance and solicits such action. If a telephone interview will advance the allowance of the application, enabling an Examiner's amendment or other meaningful discussion of the case, Applicant requests the Examiner contact Applicant's representative at the number listed below.

It is not believed that any additional fees are due; however, in the event any additional fees are due, the Examiner is authorized to charge Applicant's attorney's deposit account no. 03-2030.

Respectfully submitted,

CISLO & THOMAS LLP

Date: April 28 2004



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Enclosure

As described above

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